

REMARKS

The Office Action mailed November 12, 2009, has been received and reviewed. Claims 1-17 and 29-36 are currently pending in the application. Claims 34-36 are allowed. Claims 1-17 and 29-33 stand rejected. Applicant has amended claims 1, 6, 17 and 29, and respectfully requests reconsideration of the application as presented herein. Support for Applicant's claim amendments is found in at least Applicant's allowed claim 34. No new matter has been added.

35 U.S.C. § 103 Obviousness Rejections

Obviousness Rejection Based on U.S. Pat. No. 6,901,062, U.S. Pat. No. 6,870,824 and U.S. Pat. No. 7,352,796.

Claims 1-4, 6-12, 17 and 29-32 were rejected as being unpatentable over U.S. Patent No. 6,901,062 to Scherzer *et al* ("Scherzer") in view of U.S. Patent No. 6,870,824 to Kim *et al* ("Kim") and further in view of U.S. Patent No. 7,352,796 to Von der Embse ("Von der Embse"). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, "[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art . . . it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilsfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-4, 6-12, 17 and 29-32 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

The Office Action concedes:

Scherzer et al. and Kim et al. do not disclose determining whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned to said one of the groups as a function of the data rate. (Office Action, p. 3; emphasis added).

Applicant respectfully asserts that Applicant's amended independent claims 1, 6, 17 and 29, each recite, *inter alia*, “*encod[ing] communications ... at a data rate at least a portion greater than a first data rate supported by a dedicated traffic channel* of the one of the subscriber stations” and “*determin[ing] whether to spread* at least the portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes [for supplemental traffic channels] supporting a second data rate adequate to handle the portion.*” Specifically, Applicant's invention claims “*determin[ing] whether to spread* at least the portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes [for supplemental traffic channels] supporting a second data rate adequate to handle the portion.*”

The Office Action then alleges:

Von der Embse ... teaches determining whether to spread at least a portion of communications to said one of the subscriber stations with one of the orthogonal codes assigned to said one of the groups as a function of the data rate (“... users are group into the data rate categories corresponding to their respective code chip lengths 2, 4,’ col. 2, lines 49-67, col. 3, lines 35-67). (Office Action, p. 3; emphasis added).

Applicant does not concede that Von der Embse teaches as alleged, however, Applicant's invention as presently claimed recites, *inter alia*, “*a data rate at least a portion greater than a first data rate supported by a dedicated traffic channel* of the one of the subscriber stations ... *determin[ing] whether to spread* at least the portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes [for supplemental traffic channels]*

supporting a second data rate adequate to handle the portion" which is not taught by Von der Embse.

While the Office Action alleges Von der Embse teaches "determining whether to spread at least a portion of communications", Von der Embse teaches no such thing. Specifically, Von der Embse, at the alleged citation, merely teaches grouping users with similar chip length codes drawn from the same Walsh code matrix. (Von der Embse, col. 2, lns. 53-55). Clearly such teaching in Von der Embse does not support the conceded missing teachings in Scherzer and Kim, and, Von der Embse clearly does not teach the conceded missing element as presently amended.

Therefore, since neither Scherzer nor Kim nor Von der Embse teach Applicant's claimed invention including "*a data rate at least a portion greater than a first data rate supported by a dedicated traffic channel* of the one of the subscriber stations ... *determining whether to spread* at least the portion of *communications* to said to one of the subscriber stations *with one of the orthogonal codes [for supplemental traffic channels] supporting a second data rate adequate to handle the portion*", these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in amended independent claims 1, 6, 17 and 29. Accordingly, Applicant respectfully requests the rejection of amended independent claims 1, 6, 17 and 29 be withdrawn.

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 2-4, 7-12 and 30-32 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 2-4, 7-12 and 30-32 which respectively depend therefrom.

Obviousness Rejection Based on Scherzer, Kim, Von der Embse and U.S. Pat. No. 6,424,631.

Claims 5, 13-16 and 33 were rejected as being unpatentable over Scherzer in view of Kim and Von der Embse and further in view of U.S. Patent No. 6,424,631 to Czaja *et al.* ("Czaja"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 1, 6 and 29 precludes a rejection of claims 5, 13-16 and 33 which respectively depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claims 1, 6 and 29 and claims 5, 13-16 and 33 which respectively depend therefrom.

Allowed Claims 34-36

Claims 34-36 are allowed. Applicant acknowledges this indication with appreciation.

CONCLUSION

Claims 1-17 and 29-36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

Dated:

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